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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,727	11/15/2001	Richard Della Santa	Q67273	7667

7590 08/19/2003
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EXAMINER

GOODWIN, JEANNE M

ART UNIT PAPER NUMBER

2841

DATE MAILED: 08/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,727

Applicant(s)

DELLA SANTA, RICHARD

Examiner

Jeanne-Marguerite Goodwin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Specification

1. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

In this case, proper headings should be added to the specification, respectively.

Claim Objections

2. Claims 1, 3 and 4 are objected to because of the following informalities:
- a. Claim 1, line 2: "the first" lacks antecedent basis,
 - b. Claim 1, line 4: "(hereinafter "shutters")" should be deleted for claim clarity,
 - c. Claim 1, line 8; claim 2, line 1: "--holding--" should be added before "means" for antecedent purposes,
 - d. Claim 3, line 3: "ball" should be replaced by "--balls--" for grammar purposes.

Appropriate correction is required,

- e. Claim 4, line 1: "said ball" lacks antecedent basis.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, line 2: the phrase "in the ends" is confusing and indefinite because it is not clear what ends the Applicant is claiming

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 2,236,650 to Pujol [hereinafter Pujol].

Pujol discloses a watch comprising an elongated shape case enclosing a movement, a first and second strand wristband (6) secured to the case by metal strips (5), two pivotal shutter-type covers (10/11) being open or closed using a pivotal pin assembly, a guide/toes (23), and spring fingers/holding means (2), wherein the guide/toes and spring fingers/holding means are distinct from each other and wherein spring fingers/holding means are implemented to exert a vertical force under each of the shutters tending to apply said shutter against said spring fingers/holding means, the holding means include at least two cylindrical pin and groove assemblies (see column 2, lines 1-38). Pujol discloses all the subject matter claimed by applicant with the exception of the limitations stated in claim 1, i.e., the shape of the wristwatch and the sliding shutter covers; the limitation stated in claim 2, i.e., the ball and spring assembly; the limitation stated in claim 6, i.e., the grooves; the limitation stated in claim 7, i.e., a sealing gasket; and the limitation stated in claim 9, i.e., screws to secure the wristband to the case.

With respect to the limitation stated in claim 1, i.e., the shape: the shape of the wristwatch, i.e., rectangular, absent any criticality, is only considered to be an obvious modification of the shape of the wristwatch disclosed by Pujol as the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by applicant is nothing more than one of numerous shapes that a

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person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention. See *In re Dailey*, 149 USPQ 47 (CCPA 1976).

With respect to the limitation stated in claim 1, i.e., sliding shutter covers: this limitation, absent any criticality, is only considered a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results will be obtained if the pivotal shutter cover assembly is used to cover the case, as already illustrated by Pujol, 2) the sliding shutter cover assembly, as claimed by Applicant and the pivotal shutter cover assembly used by Pujol are well known alternate types of shutter cover assemblies which will perform the same function, if one is replaced with the other, of covering the case, and the 3) the use of shutter cover assembly is considered to be nothing more than the use of one of numerous and well known alternate types of shutter cover assemblies used to cover a case of a wristwatch that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to cover the case. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the pivotal shutter covers, as taught by Pujol, with a sliding shutter covers, since both are alternative types of shutter cover assemblies which will provide the same function, if one is replaced with the other, of covering the case, respectively.

Furthermore, it has been held that the recitation that an element is "capable" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. See *In re Hutchison*, 69 USPQ 138.

With respect to the limitations stated in claims 2 and 6: this limitation, absent any criticality, is only considered a choice of engineering skill, choice or design because 1) neither

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non-obvious nor unexpected results will be obtained if the pivotal pin assembly is used to open and close the shutter covers, as already illustrated by Pujol, 2) the ball/spring assembly, as claimed by Applicant and the pivotal pin assembly used by Pujol are well known alternate types of opening/closing assemblies which will perform the same function, if one is replaced with the other, of opening and closing the shutter covers, and the 3) the use of the ball/spring assembly is considered to be nothing more than the use of one of numerous and well known alternate types of opening/closing assemblies used to open and close the shutter covers of a wristwatch that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to open and close the shutter covers. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the pivot pin assembly, as taught by Pujol, with a ball/spring assembly, since both are alternative types of opening/closing assemblies which will provide the same function, if one is replaced with the other, of opening and closing the shutter covers, respectively.

With respect to the limitation stated in claim 9, i.e., screws to secure the wristband to the case: this limitation, absent any criticality, is only considered a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results will be obtained if the case/wristband assembly is used to attach case to the user, as already illustrated by Pujol, 2) the case/wristband assembly, as claimed by Applicant and the case/wristband assembly used by Pujol are well known alternate types of case/wristband assemblies which will perform the same function, if one is replaced with the other, of attaching the case to the user, and the 3) the use of case/wristband assembly is considered to be nothing more than the use of one of numerous and well known alternate types of case/wristband assemblies used to attach case to the user that a

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person having ordinary skill in the art would have been able to provide using routine experimentation in order to attach the case to the user. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the case/wristband assembly, as taught by Pujol, with case/wristband assembly, since both are alternative types of case/wristband assemblies which will provide the same function, if one is replaced with the other, of attaching the case to the user, respectively.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 disclose related devices. Imruth et al. teaches a ball/spring locking assembly; Alix, Dinstman, Kuo, Guyard et al., Nakazawa et al., Kikuchi, Sato et al. and Juillerat teach timepieces having cover assemblies.

8. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Examiner Jeanne-Marguerite Goodwin whose telephone number is (703) 305-0264. The examiner can normally be reached on Monday-Friday (9am-6pm), alternate Fridays off. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7724. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

JMG
Aug. 8, 2003



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